

REMARKS

Applicants would like to express appreciation to the Examiner for the detailed Official Action provided, for the acknowledgment of Applicants' Information Disclosure Statements (IDS) by return of the Forms PTO-1449, and for the acknowledgment of Applicants' Claim for Priority and Receipt of the certified copy of the priority documents in the Official Action. Upon entry of the present paper, claims 1 and 3 will have been amended and claims 15-17 will have been added. Claims 1-17 are pending before the Examiner. Applicants note that claim 3 has been amended solely to correct clerical errors therein. Applicants respectfully request reconsideration and withdrawal of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate.

The Examiner has objected to the Title of the Invention, requiring a more descriptive title. In compliance with the Examiner's requirement, Applicants have provided herein a new Title, and respectfully request that the Examiner withdraw this objection.

The Examiner has rejected claims 1-2 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,307,590 to YOSHIDA, finding that this reference teaches all limitations of these claims.

Applicants respectfully traverse the Examiner's rejection, and note that the "sealing member" (package 40) of YOSHIDA does not seal the image pickup light path between the shutter and the image pickup element; however, solely for cosmetic purposes and to expedite the patent application, Applicants have amended claim 1 to clarify that the sealing member is configured to "seal an image pickup light path extending from the shutter to the image pickup element," thereby explicitly reciting what was already implied in this claim. To the contrary, the "sealing member" of YOSHIDA does not extend from the shutter 11 (shown, *inter alia*, in Fig. 5 of YOSHIDA).

With respect to the Examiner's rejection of dependent claim 2, Applicants note that the "sealing member" (package 40) of YOSHIDA is not tubular, but rather is cuboidal in shape, as

shown in Figs. 8-9 of YOSHIDA. Further, since this claim is dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, this claim is also allowable for at least the reasons discussed *supra*.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claim 1 and the claim dependent therefrom, these claims (as well as newly-added claim 15) are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102.

The Examiner has rejected claims 3-8 under 35 U.S.C. § 103(a) as being unpatentable over YOSHIDA in view of U.S. Patent Publication No. 2003/0169333 to YAZAWA.¹ With respect to independent claim 9, the Examiner has found that YOSHIDA teaches all limitations of this claim except the frame member being provided with at least one of a low-pass filter and an infrared absorption filter secured thereto, but has found that YAZAWA teaches a frame member provided with at least one of a low-pass filter and an infrared absorption filter secured thereto.

Applicants respectfully traverse the Examiner's rejection. YOSHIDA and YAZAWA, when taken alone or in any proper combination, fail to teach or suggest at least a frame member configured to restrict an aperture which is opened and closed by the shutter, said frame member being provided with at least one of a low-pass filter and an infrared absorption filter secured thereto, as claimed in independent claim 9. With respect to YAZAWA (which is directed to an endoscope), which the Examiner has used to supply the deficiencies of YOSHIDA (for the teaching of frame member being provided with at least one of a low-pass filter and an infrared absorption filter secured thereto), Applicants note that this reference merely discloses an optical filter, and completely fails to disclose

¹ Applicants note that the Examiner appears to have intended to reject claims 3-9 and 12 under 35 U.S.C. § 103(a) as being unpatentable over YOSHIDA in view of U.S. Patent Publication No. 2003/0169333 to YAZAWA, and the present Amendment is being presented under this assumption. Applicants request confirmation in this regard.

a shutter, let alone a shutter in relation to a frame member. Rather the optical filter of YAZAWA is mounted to an imaging element frame 21 which is not configured to restrict an aperture which is opened and closed by the shutter (there being no shutter in YAZAWA). Applicants thus submit that there is no proper motivation to combine the filters of YAZAWA with the camera of YOSHIDA in any manner which would render unpatentable the present claimed invention.

Thus, one of ordinary skill in the art would not turn to YAZAWA to supply the acknowledged deficiencies of YOSHIDA at least because the teachings of YAZAWA are not directed to a frame member configured to restrict an aperture which is opened and closed by the shutter, the frame member being provided with at least one of a low-pass filter and an infrared absorption filter secured thereto. Therefore, the Examiner has not presented sufficient motivation for the proposed modification, and the only reason to combine the teachings of the applied prior art results from a review of Applicants' disclosure and the application of impermissible hindsight.

The Examiner has rejected claims 10-11 under 35 U.S.C. § 103(a) as being unpatentable over YOSHIDA in view of YAZAWA and in further view of the Examiner's Official Notice. Applicants respectfully traverse the Examiner's rejection and note that since these claims (as well as newly-added claims 16-17) are dependent from allowable independent claim 9, which is allowable for at least the reasons discussed *supra*. Thus, these dependent claims (as well as newly-added claims 16-17) are also allowable for at least the reasons discussed *supra*. Further, all dependent claims set forth a further combination of elements neither taught nor disclosed by any of the applied references. For example, with respect to the Examiner's Official Notice, Applicants respectfully traverse such Official Notice (at least in view of the arguments provided *supra*), as it is entirely without support. Also, as discussed *supra*, YAZAWA completely fails to disclose a shutter and thus could not possibly teach that the low-pass filter is closely secured to the frame member which is located closer to the image pickup element than the shutter, as claimed in claim 11. Thus, Applicants respectfully

request that the Examiner provide support for such Official Notice by identifying, *e.g.*, a reference. It is thus respectfully requested that the Examiner withdraw the rejection of claims 10-11 under 35 U.S.C. § 103(a).

The Examiner has rejected claims 13-14 under 35 U.S.C. § 103(a) as being unpatentable over YOSHIDA in view of YAZAWA and in further view U.S. Patent No. 5,050,014 to MAEDA. Applicants respectfully traverse the Examiner's rejection and note that since these claims (as well as newly-added claims 16-17) are dependent from allowable independent claim 9, which is allowable for at least the reasons discussed *supra*. Thus, these dependent claims (as well as newly-added claims 16-17) are also allowable for at least the reasons discussed *supra*. Further, all dependent claims set forth a further combination of elements neither taught nor disclosed by any of the applied references. It is thus respectfully requested that the Examiner withdraw the rejection of claims 13-14 under 35 U.S.C. § 103(a).

Thus, Applicants respectfully submit that each and every pending claim of the present application meets the requirements for Patentability at least under 35 U.S.C. §§102 and 103, and respectfully request the Examiner to indicate the allowance of each and every pending claim in the present application.

SUMMARY AND CONCLUSION

In view of the fact that none of the art of record, whether considered alone, or in any proper combination thereof, discloses or suggests the present invention, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

Applicants note that this amendment is being made to advance prosecution of the application to allowance, and no acquiescence as to the propriety of the Examiner's objection or rejection is made by the present amendment. The amendments to the claims have not been made for a purpose related to patentability, but rather are clarifying amendments that are cosmetic in nature by rendering explicit what was already implied in these claims, as discussed *supra*. The amendments to the claims should thus be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto. Accordingly, this amendment should not be considered a decision by Applicants to narrow the claims in any way.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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